

REMARKS/ARGUMENTS

Drawings

Examiner has stated that Applicant has not properly submitted the drawing change per MPEP 608.02(p). In response, Applicant has now properly submitted the drawing change.

Claim Rejections – 35 USC 102

DeTitta as an Improper Reference

In Amendment A, Applicant stated

DeTitta is an improper reference due to the fact that it does not provide a description that is adequate so that one of ordinary skill in the art would be able to make and use the invention as presently claimed.

In response, Examiner stated:

Since DeTitta is an issued United States Patent, it is presumed valid and fulfilling Section 112 criteria (see 35 USC 282); therefore, DeTitta is a proper reference.

In response, Applicant would like to clarify that he never intended to suggest that DeTitta is invalid or valid. DeTitta's specification may very well be more than sufficient to provide enabling support for DeTitta's claims. However, it should be noted that none of DeTitta's claims require for their support the section Examiner has relied upon in rejecting Applicant. Specifically, DeTitta does not claim the plate imaging system described in column 10. Therefore, it cannot be presumed that the description of the plate imaging system is adequate to enable one of ordinary skill in the art make and use either the plate imaging system disclosed in DeTitta and it cannot be presumed that the description of the plate imaging system is adequate to enable one of ordinary skill in the art to make and use Applicant's device for inspecting and classifying a plurality of microscopic crystals.

In order to rely on a prior art document to reject a claim (in this case under 35 USC 102) Examiner must show that the present invention is disclosed in that prior art document in sufficient detail to permit a person skilled in the art to practice the present invention as claimed in the present application. Therefore, in order for DeTitta to qualify as prior art in this case, DeTitta must enable a person of ordinary skill in the art to practice Applicant's invention as Applicant has claimed it. This cannot be presumed to have occurred merely because DeTitta has issued as a U.S. Patent that included a reference to a device that accomplishes the objectives of Applicant's invention.

To draw an analogy, much like DeTitta's explanation of the plate imaging system, a science-fiction novel might describe an invention without going into its details. For example, the *Star Trek* television series discloses a transporter by which Starfleet personnel can be "beamed up" from the surface of a planet to the Starship Enterprise. However, there are no details on how the transporter is made or on how it works. Therefore, if someone today invented a transporter similar to that depicted in *Star Trek*, he should be able to get a patent on it. In this case, DeTitta merely refers to a device like the one Applicant has built, tested and described in detail. However, DeTitta did not provide sufficient detail to permit a person skilled in the art to make and use the invention. Nor would the present invention have been obvious to persons skilled in the art based on the mere reference by DeTitta to the device. Therefore, while DeTitta may be presumed to be enabling with respect to DeTitta's claims, DeTitta is non-enabling with respect to Applicant's claims.

Therefore, Applicant respectfully requests that unless Examiner is able to provide an enabling reference regarding Independent Claims 1, 13 and 30, that Examiner allows Claims 1, 13 and 30 as presently amended. Moreover, Claims 2 – 12 depend on Claim 1, Claims 14 – 29 depend on Claim 13, and Claims 31 – 41 depend on Claim 30. The dependent Claims just mentioned should all be allowable for the reasons stated above.

Claim 29

In rejecting Claim 29, Examiner has stated that DeTitta discloses the following element:

B) making a determination as to what is present if said microscopic crystal does not exist.

Examiner states that DeTitta shows this element at col. 11, line 14, where it states (t)he results were encoded “nothing happened” by zero (0), and “something happened” by one (1)...

In response, Applicant has amended Claim B so that it now states

B) making a choice from a list of predetermined descriptions as to what is present if said microscopic crystal does not exist

Applicant respectfully submits that by encoding a “0” when nothing happens is not the same or similar to “making a choice from a list of predetermined descriptions as to what is present if said microscopic crystal does not exist.” Table 1 on page 17 provides an example of a list of predetermined descriptions. As can be clearly seen, there is a wide range of possibilities for classification other than “nothing happened”.

Also, in rejecting element C of Claim 29, Examiner states

However, DeTitta does not teach a determination of quality although DeTitta does teach such a feature. C) making a determination as the qualities of said microscopic crystal if said microscopic crystal does exist (uniform, granular or microcrystalline, p. 402, col. 1).

In response, Applicant submits that it is clear that Examiner made a typographical error and meant to state that “... Jurisica does teach such a feature.” However, Examiner has stated that “The declaration filed on February 19, 2003 under 37 CFR 1.131 is sufficient to overcome the Jurisica reference.” Therefore, Examiner has not provided a reference that shows the element “C” as presently amended.

Because neither DeTitta nor any other reference discloses Claim 29 as presently amended, Applicant respectfully requests that Claim 29 be allowed.

New Claims 42 and 43

Examiner has suggested that some claims could be allowable if Applicant would

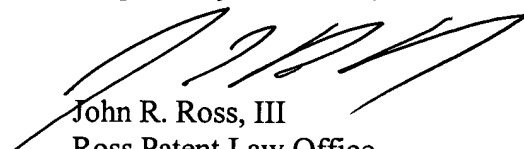
. . .claim the novel or the non-obvious features disclosed in the specification (e.g., details of the automatic classification computer program) that allow the instant invention to provide a method of and device for inspecting and classifying a plurality of microscopic crystals.

In response, Applicant has drafted new claims 42 and 43 as suggested by Examiner. Therefore, Claims 42 and 43 should be allowable.

CONCLUSION

Thus, for all the reasons given above, this application, as the claims are presently limited, define a novel, patentable, and truly valuable invention. Hence allowance of this application is respectfully submitted to be proper and is respectfully solicited.

Respectfully Submitted,



John R. Ross, III
Ross Patent Law Office
Regis. No. 43060
PO Box 2138
Del Mar, CA 92014
Phone: 858-755-3122
Fax: 858-755-3122